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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/529,719	10/03/2005	George Tiri Tomka	05-231	9101
20306 7590 02/21/2008 MCDONNELL BOEHNNEN HULBERT & BERGHOFF LLP 300 S. WACKER DRIVE 32ND FLOOR CHICAGO, IL 60606				
EXAMINER				
HARRIS, GARY D				
ART UNIT		PAPER NUMBER		
1794				
MAIL DATE		DELIVERY MODE		
02/21/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/529,719

Applicant(s)

TOMKA ET AL.

Examiner

GARY D. HARRIS

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/5/07.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 4-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Response to Amendment

Examiner acknowledges amendments to claims 1, 8 and 11 and cancelled claims 2 & 3. Examiner has included Chou et al. in references cited.

Response to Arguments

Applicant's arguments filed on 12/05/2007 have been fully considered but they are not persuasive. Applicant argues that the reference does not disclose a deposition promoting material. Applicant has not claimed the deposition promoting material in the body of the claim and the deposition promoting material could be interpreted as anything that would promote deposition including chemical/physical etching a metal or anything that comes in contact with the substrate (including but not limited to an oxide layer forming) Chou et al. discloses substrate treatment (Col. 13, Line 1-23) and/or metal coated substrates (Col. 3, Line 1-8) and/or involve sensitizing the surface which examiner interprets as adhesion promoting as disclosed by Chou (Col. 12, 13 Line 33-68, 1-14 respectively).

For convenience the rejection is substantially repeated below:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 4, 5, 6, 7, 8, 9, 10 & 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davies US 5,582,924 in view of Chou et al. US 5,322,751.

As to Claim 1 & 4, Davies '924 describes a magnetically activated tag made by electroless deposition of soft magnetic material (Col. 1, Line 62-65). Davies '924 discloses the use of printing as a mask for the use of screen printing, roller or suitable pattern and the application of nonmagnetic materials, Davies '924 does not disclose deposition promoting materials by print transfer mechanism including ink-jet. However, the deposition promoting material is not disclosed in the claim and could be interpreted as any surface treatment. Chou et al. 751 discloses treating the surface prior to adhesion (Col. 13, Line 1-23) and discloses metallic coatings being transferred using printing techniques and electroless plating solutions (Col. 14, 15, Line 60-69, 1- 11 respectively). It would be obvious to one skilled in the art to use the method of Chou '751 in the Davies invention in order to apply a second metallic coating (Col. 21, Line 59-66).

As to Claim 5, Davies '924 discloses deposition of soft magnetic material and electroless deposition for use on a tag (Col. 1, Line 9-11 & 26-29).

As to Claim 6, although Davies '924 does not claim a biasing field, applicant has not described the limits of the biasing field and in the broadest sense; earth's magnetic field would be a bias the electroless deposition reaction.

As to Claim 7, 8 & 11, Davies '924 discloses the use of hard and soft magnetic materials (Col. 1, Line 26-33) and Davies discloses a magnetic tag with information bits made from soft and hard magnetic materials.

As to Claim 9 & 10, Davies discloses the use of patterned hard and soft magnetic materials (Col. 3, Line 56-65) and the use of heat treatment that would affect the magnetic bias (Col. 3, Line 35-40). A magnetic bias would be an inherent feature of the materials, as two different magnetic materials would naturally bias one another. Because the applicants and the inventors teach virtually identical structures with similar materials they would be inherently the same. The physical properties of similar materials will inherently be similar. The burden of proof is shifted to the applicant to show the prior art properties are different from those claimed. See *In re Fitzgerald*, 619 F. 2d 67, 205 USPQ 594 (CCPA 1980).

Examiner additionally notes that claims 7-11 are article claims with product by process limitations. The patentability of a product is independent of how it was made. *Ex parte Jungfer* 18 USPQ 1796, 1800 (BPAI 1991); *Brystol-Myers Co. v. U.S. International Trade Commission* 15 USPQ 2d 1258 (Fed. Cir. 1989). The burden is on

applicants to show product differences in product by process claims. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). See MPEP 2113.

Column and line numbers are provided for convenience. However the entire reference should be considered.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GARY D. HARRIS whose telephone number is (571)272-6508. The examiner can normally be reached on 8AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith D. Hendricks can be reached on 571-272-1401. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Holly Rickman/
Primary Examiner, Art Unit 1794
for Gary Harris